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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/609,801      | 07/03/2000  | Roger P. Hoffman     | P/2-63              | 4244             |

7590 11/05/2002

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EXAMINER

WEISBERGER, RICHARD C

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3624

DATE MAILED: 11/05/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/609,801

Applicant(s)

HOFFMAN, ROGER P.

Examiner

Richard C. Weisberger

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, "encoded" is vague, indefinite and without particularity.

In claim 4 and elsewhere, said system allowing for information to be transferred is vague and indefinite. What structural element is this directed to?

In claim 4 and elsewhere, said text document being part of an email server is vague and indefinite. It is not clear how this limits the text document.

In claim 11, further information being imputed by a wireless device is vague and indefinite. It is not clear how this limits the system.

Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements.

See MPEP § 2172.01. The omitted elements are the elements of the system that render it operable.

Claim 12 vague and indefinite: How is the wireless connected to the email account.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Concur Technologies, Portable Software, Press Release

The prior art teaches that Portable Software Corporation, are makers of the Xpense Management Solution™ (XMS)—the leading enterprise client/server travel and entertainment (T&E) expense management software. It has teaches that Vantive Corporation will assist Portable Software in hiring additional development, systems integration, and sales staff to quickly support the worldwide demand for Portable Software's flagship travel and entertainment expense management software, the Xpense Management Solution (XMS).

Portable Software's Xpense Management Solution is an integrated client/server solution that dramatically reduces processing costs by streamlining and automating the entire travel and entertainment expense management process—from expense report preparation, approval, and processing through systems integration and data analysis. With XMS™, preparing expense reports is easier and business travelers are reimbursed faster. Accounting is more productive because reports are delivered on-line and automatically link to financial systems, eliminating the need to re-key expenses. XMS ensures that expense reports are complete, accurate, approved and in compliance with corporate policy. With robust expense data easily accessible, management can analyze T&E trends, manage cash flow, and negotiate better vendor rates. And XMS seamlessly

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integrates with a company's existing and future charge cards and financial, travel, email, and operating systems.

Portable Software Corporation develops and markets travel and entertainment (T&E) automation software and services. Its products are designed to serve the entire enterprise, from business travelers to corporate accounting departments. The company's flagship product, the Xpense Management Solution (XMS), is the most complete T&E expense software available on the market and has been adopted by more Fortune 1000 and multinational companies than any other automated T&E expense management solution. Portable Software Corporation is headquartered in Redmond, WA, USA with offices in Boston, New York, Philadelphia, Washington DC, Atlanta, Chicago, Minneapolis, Dallas, Los Angeles, Seattle, and London, England.

The primary reference fails to teach the method of opening the account by swiping a card having a person email address. The secondary reference teaches that internet based transaction enabling systems comprising a card and a URL address are well known. It would have been obvious for one skilled in the art used this system to initiate the recording the travel and expenses information of the primary reference as motivated by the need to increase efficiency.

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Respectfully Submitted

By, 

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